

No. 9811

IN THE

United States Circuit Court of Appeals

For the Ninth Circuit

MASICK C. MAGARIAN,

*Plaintiff and Appellant,*

vs.

DETROIT PRODUCTS COMPANY, a copart-  
nership composed of FLOYD E. WAL-  
LACE and PERCY J. ELWELL,

*Defendants and Appellees.*

APPELLANT'S REPLY BRIEF.

ADELBERT SCHAPP,

Hobart Building, San Francisco,

*Attorney for Appellant.*

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## APPELLANT'S REPLY BRIEF.

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Appellees, in their brief, have raised a few points which are thought to require a reply. For the sake of simplicity, these points will be discussed in the form of a commentary upon appellees' brief, reference being had to the page numbers thereof.

Page 11: Appellees allege that there is nothing in the drawing to show that the common separator is coextensive with the lens-receiving space. A glance at Figure 2 of the drawing in the utility patent will prove the contrary. (Book of Exhibits, page 264.) This Figure clearly shows the separator in dotted lines as extending throughout the width and the length of the lens-receiving chamber. The specification through-

out refers to "the separator" in the singular, as for instance (Page 2, lines 19 and fig.), "The separator \* \* \* is placed on top of the lenses", which plainly implies that there is only one separator for all the lenses.

Page 15: Appellees' claim that there is no disclosure in the specification of the Magarian Patent that the body sections exert "uniform pressure" on the interposed lenses. This feature is clearly inherent in the structure shown and described. Figures 1 and 4 definitely show that the body portions of the plates are parallel. Figure 4 shows the separator as extending in uniform thickness from one pair of lenses to the next one. The lenses necessarily are all alike, are shown as being alike, and only one kind of lens has been described. The specification states that the plates are identical and that the body portions run parallel to the margins. The clamping action is clearly described in the following sentence (Page 2 of the patent, Column 1, lines 7 to 12):

"Between the lenses I interpose a separator, and the different parts are arranged and dimensioned so that when assembled the marginal portions of the body sections of the plate bear on the flanges of the lenses and clamp the same from opposite sides upon the separator."

If that does not clearly express the gist of the invention as defined in Claims 3 and 4, it is difficult to say what would. Apparently, the Examiner of the Patent Office had no difficulty in understanding the invention from the specification and drawing.

That, under these circumstances, no supplementary oath was required, is apparent. See, for instance, Walker, Deller's Edition, Page 867:

“A supplementary oath is not, however, necessary to cover claims additional to those originally filed, where the addition of claims are within the invention as originally disclosed.”

Page 17: This page contains two misleading statements, made in an effort to disprove that Magarian pioneered the idea of applying the Stimsonite lens to a signaling arm. Appellees wish the Court to gain the impression that Stimson, himself, first suggested the idea of using the lens for signaling arms, and quote from the Stimson Patent as follows:

“This invention relates to reflecting devices and more particularly to reflecting devices of the character designed for signalling and aids to traffic.”

The above statement certainly does not mention signaling *arms*, and the testimony clearly shows that the Guide Lamp Corp. made the Magarian lenses only after Magarian had suggested the idea and had solved the problem of applying them. (Book of Exhibits, Pages 270-271; Tr. Page 39 and fig.)

Appellees further suggest that the idea came from the California State Motor Vehicle Department, because Wallace testified that it was at the suggestion of Mr. Sharkey of the State Motor Vehicle Department, that he (Wallace) wrote to the Guide Lamp Company to obtain Stimsonite reflectors. But, this was in 1938, at least fifteen months after Magarian

had submitted his patented arm to the same State Department. (Book of Exhibits, Page 272.)

There is no suggestion in the record which would deprive Magarian of the distinction of having pioneered the idea of applying the Stimsonite lens to a signaling arm.

Page 20: The principle of the Patent Law that a genuine combination can only be anticipated by a similar combination shown in a single reference, is too well established to require discussion. Any decisions which seemingly hold to the contrary, can be readily distinguished as referring to aggregations rather than combinations, that is, to cases in which no new functional relationship arises from the combination, as was pointed out in the very decisions relied on by appellees. (*Mettler v. Peabody Engineering Corp.*, 77 Fed. (2d) 56, and *Bailey v. Sears Roebuck & Company*, 115 Fed. (2d) 904.)

Page 21: The statement on Page 21 that counsel admitted during the pre-trial procedure that all the elements in Plaintiff's patent were old, apparently is unfounded, and not substantiated by anything in the record. While, broadly speaking, plates and lenses and separators, may not be new, one would look in vain for Magarian's particular plate, Magarian's particular lens, and Magarian's particular separator in any of the prior art structures. The Appellees have not even attempted to do this.

Pages 23 to 29: Referring to the design patent, Appellees, for the first time, raise the point that the



novelty in the design patent allegedly is dictated only by utilitarian considerations. This point was not mentioned in the answer, was not mentioned during the entire trial, was not discussed in any previous brief, and was not made the subject of any finding. It, no doubt, is an afterthought, and the fact that it was not mentioned once during the entire previous proceedings carries a strong suggestion that, even in the opinion of counsel, it does not exactly fit into the circumstances of the present case.

A brief discussion of the authorities cited on behalf of this proposition will convincingly show that, wherever this point was advanced by the Courts, the facts may be readily distinguished from those of the present case.

In *Applied Arts Corp. v. Grand Rapids Metalcraft Corp.*, 67 Fed. Sec. 428, validity was not in issue, and the Court merely held in substance that the patentee could not claim any more than his own contribution over the prior art, which, of course, is one of the basic principles of our Patent System. Appellant does not claim infringement of any particular features shown in the prior art; he does claim that he has created a new article which in its overall aesthetic effect belongs in a class by itself as distinguished from the prior art; and that Appellees have copied this overall aesthetic effect.

In *Man-Sew Pinking Attachment Corp. v. Chandler Machine Company* (33 Fed. Suppl. 950), validity likewise was not in issue. The accused machine was similar mechanically to that of the patentee. It had the same

essential parts and was designed to fit into the same sort of cut-out. Consequently the machines looked somewhat alike, though they were by no means identical. In the present case, the signaling arm is an independent article, does not fit into any particular cut-out, and may be made of almost any shape the user's fancy may dictate.

In *Weisgerber v. Clowney*, 131 Fed. 477, the Appellees quote only one-half of the sentence; the full sentence reads as follows:

“A design patent is addressed to the eye and is to be judged by its ability to please (citation). There may be no objection to the article to which it relates being useful, as well as ornamental, but the attempt to patent a mechanical function, under cover of a design, is a perversion of the privilege given by the statutes.”

The case was not decided on this point, but on differences pointed out by the Court. In the present case, Appellant does not attempt to patent a mechanical function by means of the design patent.

In *Straus Gas Iron Company v. William M. Crane Co.*, 235 Fed. 126, and in *North British Rubber Company v. Ronne Rubber and Tire Company*, 271 Fed. 936, the aesthetic feature was held to be entirely absent, one of the cases holding that the article in question was “incapable of being the subject of design patent, for want of reason to suppose that its appearance can ever really matter to anybody”.

*Ex Parte Kern*, Commissioner's Decisions for 1903, Page 292, only holds that if the configuration is

merely due to fitting a part into the place where it is to be used, such appearance must be eliminated from consideration of the subject-matter as an ornamental design. In the present case, the signal arm is an independent device, not intended for fitting into any particular place, and the aesthetic appearance is not dependent upon the construction shown in the utility patent.

In fact, the same aesthetic appearance might be created by omitting the separator, the flanges on the lenses, and the clamping action altogether, as, for instance, by making the two plates in one piece, possibly solid throughout, and gluing the oval portions of the lenses on the outside. This would produce exactly the same appearance and still would be a radically different structure which would be altogether outside the scope of the utility patent.

The Commissioner's Decision *Ex Parte McGowen*, 336 O. G. 3, discussed at length by Appellees on Pages 26 and 27, runs parallel to the present case only insofar as in both cases both applications were filed on the same date. They are utterly at variance insofar as in the cited case the Commissioner refused both patents, while in the present case, the Commissioner allowed both patents.

Page 35: Under the heading "The Plaintiff is Guilty of Unclean Hands", the brief states:

"No information concerning Plaintiff's Exhibit A was ever divulged by Magarian or his attorney to the Examiner of the Patent Office."

As far as Appellant is aware, no proof was submitted by Appellees to justify this statement. There is no testimony relating to an examination of Magarian's file wrapper and there is no proof that Magarian or his attorney might not have shown the Examiner Plaintiff's Exhibit A in a personal interview. In view of these facts, the above statement is hardly justified.

But, regardless of whether or not the exhibit was shown to the Examiner, Appellant maintains that it would not have made any difference as explained in the original brief. It is only interesting to note that the Appellees themselves did not think enough of this point to actually follow it up during the trial.

Under the same heading, bottom of Page 35, the Appellees say:

“Furthermore, when it came to answering Defendants' Interrogatories filed in the Lower Court he (plaintiff) denied having made a construction embodying features of Plaintiff's Exhibit A prior to November 10, 1935.”

This statement is positively erroneous.

In response to the Interrogatory, the Plaintiff made the following statement:

“With respect to questions 7 to 10, inclusive, Affiant (plaintiff) states that the only signalling arm sold by Plaintiff prior to November 16, 1935, is the one referred to in Question 11 of the interrogatory and a specimen of this signalling arm is filed herewith as Plaintiff Exhibit A. While the specimen speaks for itself, Plaintiff has answered the questions relating to its construction in order to expedite matters.”

It thus appears that the Plaintiff-Appellant submitted the arm, Plaintiff's Exhibit A, as the very first exhibit in the case and in response to the interrogatories referred to in the brief. Any comment made on the exhibit was, therefore, merely an expression of opinion.

Page 46: On line 2, and following, the Appellees make the surprising statement:

“That the allowed claims in the Patent can never be construed to cover the same subject-matter defined by a claim presented, rejected and either cancelled or amended, see

*Deller's Edition of Walker on Patents*, page 1215, Section 249,

and the numerous cases cited therein.”

In reality, the statement referred to reads as follows:

“Where an applicant, on the rejection of his application, inserted in consequence of that rejection, limitations and restrictions into his specification for the purpose of obtaining his patent, he cannot, after he has obtained it, claim that it shall be construed as it would have been if such limitations and restrictions were not contained in it.”

How this well-known principle of the Patent Law can have any effect on the present situation, is difficult to see. Appellant does not ask for any construction of his patent, as it would have been if the limitations and restrictions added by amendment were not contained in it. He merely asks for a narrow inter-



pretation of the claims with all their limitations and restrictions and does not need to ask for any more, since the Appellees have copied every one of the limitations and restrictions contained in the claims.

Page 46: Toward the end of the brief, the Appellees give the Court the benefit of the discussion of an academic question not now before the Court. The question of jurisdiction was fully argued before the trial court and decided in favor of Plaintiff. The Defendants did not appeal from the decision and must be considered as having waived the point. An appeal brief is hardly the place for the academic discussion of an extraneous point.

Dated, San Francisco,  
November 14, 1941.

ADELBERT SCHAPP,  
*Attorney for Appellant.*